

REMARKS

Reconsideration of the present application as amended is respectfully requested. Claims 75-79 have been canceled. Claims 1-10, 12-39, 41, 43-74, 80-84, 87, 90, 103-107, 110-118, and 120-133 remain pending. No amendments to the claims are presented at this time.

Claims 1, 2, 22, 31, 32, 44, 56-60, 65, 71, 73, 80-84, 87, 115, 118, 119, 128, 132 and 133 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,832,463 to Funk ("Funk"). Applicants respectfully traverse.

Applicants have previously argued that Funk fails to teach or suggest a document scanner located at the site of a customer transaction which includes means for presenting an authorization agreement to a customer which is authorized before a particular document is processed by an automated account clearing process. The Examiner notes language in Funk which states that after the check is presented the "paper check may be truncated or marked in some way to indicate that it has been processed and returned to the customer" (col. 3, lines 65-67). The Examiner takes the position that "once the customer accepts the marked check he/she authorizes the check to be processed in accordance with an automated clearinghouse" (final Office Action, page 13). Applicants submit that the Examiner has read much more into the teachings of Funk than is either actually present or permitted.

The statements in Funk relating to marking the check after presentment refer to a common banking-required practice of "canceling" the check. A marking of the check to cancel it prevents a party from subsequently re-presenting the check. The cancellation mark on the check accordingly prevents the check holder from committing fraud. That cancellation mark does not provide any information to the presenting party concerning how the imaged check will be subsequently processed. More specifically, in connection with the claim language, the cancellation mark does not provide any indication to the presenting party that the check is going to be processed through an automated account clearing. The presenting party is completely ignorant as to how the check will be handled, whether by automated clearing house or substitute check processing or otherwise, for payment. He/she knows only from the cancellation mark that he/she cannot subsequently fraudulently represent the check for payment. Given that the cancellation mark does not inform the presenting party with any information concerning check processing and money transfer (either in general or specifically with respect to automated

account clearing), the mark does not constitute the printing of an agreement as claimed, and further it is impossible for the presenting party, in accepting the canceled check, to “authorize the check to be processed in accordance with an automated clearing house” as asserted by the Examiner.

The claimed invention addresses these issues and thus clearly distinguishes over the process taught by Funk. In Funk, it is clear that the check presenter is not informed that the check is to be handled using automated account clearing techniques. Still further, the presenter is not given any option concerning accepting such processing. In other words, the check presenter cannot agree or consent to such processing; it occurs in Funk automatically without customer knowledge or approval. In contrast, with the present invention as claimed, an authorization agreement is presented to the customer (where that authorization agreement authorizes the check to be processed using automated clearing house techniques). The customer is further afforded an opportunity to authorize (i.e., to accept) the presented authorization agreement. The check image is not communicated in the claimed invention until “following customer authorization.” The acts of offer and acceptance (through presentment of the agreement and its authorization), which are necessary in order for there to be an agreement as to automated account clearing processing, are neither disclosed nor suggested by Funk, but instead are specifically claimed in Applicants’ invention. The cancellation mark made on the check following presentment by the customer in Funk does not, as discussed above, meet the “presenting” and “authorizing” limitations recited in the claims.

Applicants further refer the Examiner to, and incorporate by reference herein, the other advantages of the claimed invention as set forth in the response to the first Office Action. The Funk processing technique does not address any of these advantages.

In order for Funk to anticipate the claimed invention, the reference must teach each and every claim limitation. In the case of independent claims 1, 32, 57, 80, 115 and 118 (as well as other independent claims with similar limitations), there is no teaching in Funk for presentment of an agreement authorizing document processing in accordance with an automated account clearing process. The Funk teaching for check/document cancellation or truncation is not a teaching of presenting the specifically claimed type of agreement. Still further, customer acceptance of such a canceled/truncated check can not constitute any form of authorization or

acceptance of the agreement to allow for automated account clearing processing. The Examiner has therefore failed to carry the required burden under Section 102 to show anticipation.

In view of the foregoing, Applicants respectfully submit that the invention of independent claims 1, 32, 57, 80, 115 and 118 (as well as other claims containing similar limitations) is patentable over Funk.¹

Claims 2, 22, 31, 44, 56, 58-60, 65, 71, 73, 81-84, 87, 128 and 132-133 are dependent upon and include the features of their respective independent claims 1, 32, 57, 80, and 118. For at least the reasons discussed with respect to independent claims 1, 32, 57, 80, and 118, Applicant respectfully submits that these dependent claims also distinguish over Funk.

Claims 3, 4, 7, 8, 15, 16, 21, 35-37, 41, 48, 49, 61-64, 120, 121, 125, and 127 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Funk in view of U.S. Patent No. 6,547,132 to Templeton et al. ("Templeton"). Initially, Applicants submit that these claims are patentable over the cited art for at least the reasons presented above with respect to claim 1.

The Examiner cites to col. 5, lines 25-33, col. 6, lines 33-36 and col. 7, lines 12+ of Templeton as teaching a printer for imprinting an authorization agreement on a check or receipt. Applicants respectfully disagree. Templeton describes a point-of-sale terminal having a printer for printing information, such as payee and amount information, on checks placed in a slot of the terminal. The portions of Templeton relied upon by the Examiner merely teach the use of a printer for printing something on the checks or other paper (such as a receipt). There is no disclosure or teaching in Templeton (or Funk), however, for printing "an authorization agreement" as is specifically claimed. Still further, Applicants note, in connection with the discussion set forth above regarding Funk, that neither cited reference relied upon by the Examiner teaches the explicitly claimed limitation for printing the authorization agreement for the document to be processed in accordance with automated account clearing.

¹ The Examiner asserts that a "broadest reasonable interpretation" has been given to Funk. Applicants respectfully disagree. As shown, not only is the Examiner's interpretation of Funk overly-broad, it is further unreasonable and illogical. The Examiner has improperly magnified the simple act of check cancellation (truncation) in Funk to meet separately recited claim limitations for presenting an agreement and customer authorization of that agreement. The Examiner has further illogically relied on an implication (i.e., acceptance of a canceled check as agreement to ACH) to meet an explicit claim limitation for customer authorization.

The Examiner further concedes that the combination of Funk and Templeton fails to teach printing indicia of a verbal authorization to the agreement. Nonetheless, the Examiner asserts the Section 103 rejection on the basis that it would be inherent to include such indicia once the authorization agreement is printed. This assertion, however, assumes that Templeton/Funk teach first imprinting the document with the agreement itself. As discussed above, there is no such teaching or suggestion in Templeton/Funk for printing “an authorization agreement for the document to be processed in accordance with the automated account clearing process” as is specifically claimed. Absent such a teaching, the issue of whether it would be inherent to imprint with a verbal authorization is irrelevant.

In view of the foregoing, withdrawal of the Section 103 rejection is respectfully requested.

Claims 5, 6, 9, 10, 38, 39, and 43 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Funk in view of Templeton U.S. Patent No. 5,175,682 to Higashiyama et al. (“Higashiyama”). These claims are dependent upon and include the features of their respective independent claims 1 and 32 and thus are believed to be in condition for allowance for at least the reasons presented above with respect to claims 1 and 32.

Claims 12, 23, 24, 45, 47, 122 and 123 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Funk in view of Templeton. These claims are dependent upon and include the features of their respective independent claims 1, 32, and 118 and thus are believed to be in condition for allowance for at least the reasons presented above with respect to claims 1, 32 and 118.

Claims 13, 14, 46, 110, 113 and 124 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Funk in view of Templeton and U.S. Patent No. 6,193,152 to Fernando et al. (“Fernando”). Claims 13, 14, 46 and 144 are dependent upon and include the features of their respective independent claims 1, 32, and 118 and thus are believed to be in condition for allowance for at least the reasons presented above with respect to claims 1, 32 and 118. Claims 110 and 113 are believed to be patentable over the art for at least the reasons recited above with respect to claim 1.

Claims 17, 18, 33, 34, 50, 51, 111, 112, 114 and 126 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Funk in view of Higashiyama. Claims 17, 18, 33, 34, 50, 51, and 126 are dependent upon and include the features of independent claims 1, 32, and 118 and thus are believed to be in condition for allowance for at least the reasons presented above with respect to claims 1, 32 and 118. Claims 111, 112 and 114 are believed to be patentable over the art for at least the reasons recited above with respect to claim 1.

Claims 19 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Funk in view of Templeton. Claims 19 and 20 are dependent upon and include the features of independent claim 1 are believed to be patentable over the art for at least the reasons recited above with respect to claim 1.

Claims 25-30, 53-55, 66-70, 72, 74, 90 and 129-131 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Funk. These claims are dependent upon and include the features of their respective independent claim 1, 32, 57, 80, and 118 and are thus considered to be patentable for at least the same reasons.

Claims 75, 78 and 79 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Funk. Claims 76 and 77 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Funk in view of Templeton. Claims 75-79 have been cancelled without prejudice.

Claims 103-107, 116, and 117 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Funk in view of Templeton. Again, Applicants reiterate that the cited Funk/Templeton references do not teach printing an authorization agreement on a check. While Templeton may teach a printer for printing on a check, there is no teaching or suggestion in either Funk or Templeton for the printing to be of an authorization agreement as claimed. Additionally, the cited Funk/Templeton references fail to teach the claimed presentation of an authorization agreement and customer authorization of that agreement as claimed. Applicants respectfully submit that independent claim 103 distinguishes over Funk in view of Templeton and request that the 35 U.S.C. 103(a) rejection of claims 103-17, 116 and 117 be withdrawn.

In view of the foregoing amendments and remarks, Applicants believe the pending application is in condition for allowance.

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Respectfully submitted,

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